



ATTACHMENT A

REMARKS

For reasons as discussed with the Examiner's Supervisor, Gary Kunz, Applicants submit that the rejections as stated by the Examiner in the prior Official Action are entirely without merit and should be withdrawn.

In the Official Action, the Examiner maintained a rejection of Claims 1-13 and 15-30 under 35 U.S.C. §112 on the basis of the enablement requirement. However, this rejection is actually a new matter rejection. In short, this rejection is based entirely on the fact that the claims refer to the compositions being "non-toxic", and the Examiner states that he was "unable to find the words "non-toxic" in the specification." See Final Rejection at page 2. However, the Examiner also **concedes** that Applicants' specification **provided adequate support** for this term stating "**the intention is evident**" that Applicants' specification disclosed non-toxic compositions.

Under these circumstances, it is clear that the Examiner is completely unaware that it is **black letter law** that the question of support in a specification is **not** based on the exact verbiage used in the specification. As indicated in the recent Federal Circuit case of All Dental Prodx, LLC and DMG Dental-Material Gesellschaft MBH v. Advantage Dental Products, Inc., 64 USPQ2d 1945 (Fed. Cir. 2002), the specification **need not** describe the claimed subject matter in **exactly the same terms as used in the claims** wherein it has indicated to persons skilled in the art that **what the applicant intended to be the claimed invention**. As the Court stated, "the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that

the new language reflects what the specification shows has been invented.” 64 USPQ2d at 1948, citing Eiselstein v. Frank, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995) and Vas-Cath, Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1115 (Fed. Cir. 1991). Since the Examiner **concedes** that Applicants “**intention is evident**” to disclose non-toxic compositions, the Examiner has **conceded** that there is support in the specification for the claimed language regarding “non-toxic” compositions.

Accordingly, the rejection under 35 U.S.C. §112 under the alleged basis of enablement, which is really a rejection on the basis of new matter, is entirely unfounded and should be withdrawn.

The only other rejection is one that is allegedly under 35 U.S.C. § 103(a) on the basis of the Page patent, but this rejection (to the extent one can interpret the jumbled sentences and lack of grammatical integrity) is also based on the Examiner’s incorrect view that the specification does not support the term “non-toxic” when in fact the Examiner concedes that it **does**. The entire paragraph of the rejection in original form (with its numerous grammatical and spelling errors included) reads as follows:

“The rejection of record is maintained even though the reference is old. Absent including the actives [sic] in their concentrations, there is no “non-toxic” for one in the art to fall back to in the instant specification to find; thus, given pages claiming the paraffin impregnate product can be applied to skin (p.1, lines 42-57), it meets the applicants insert strip, even though page does not tell us what to do with his fabric-it can be used in many ways, with equivalents of Naphthaline, along with essential oils.”

See Final Rejection, pages 2-3.

This rejection (insofar as it could be understood) is completely unfounded on every point. In the first place, as indicated above, it is clear that the major part of the rejection relies of the Examiner’s incorrect conclusion that the specification does not

disclose “non-toxic” compositions when in fact the Examiner concedes that it does. Secondly, as was pointed out in Applicants prior response, one of many ways Applicant’s claimed invention is distinguished from Page is that the Page reference only discloses a garment which is directly coated with paraffin wax which would directly touch the skin of the wearer, and the Page garment would be totally unattractive and unsaleable. On the other hand, Applicant’s claimed invention is relates to particular inserts which go on the inside of a garment and do not directly touch the wearer’s skin, which results for the first time in a saleable and attractive product (see copy of Applicant’s Declaration filed with the prior response, attached hereto, ¶¶ 3-4).

Even further, it is in fact the case that the Applicant has previously provided a Declaration which shows that the actual product has been a huge commercial success with sales of up to \$1 million per year. (See attached copy of Declaration, ¶ 5). Accordingly, in addition to the fact that the extremely old prior art Page reference (issued 1881) does not disclose or suggest the present claims, provides no motivation to achieve the present claims, and in fact describes something that is entirely opposite to the present invention, the presently claimed invention has achieved commercial success, yet another indication that the invention is **not obvious** over the cited prior art. See, e.g., Vulcan Eng’g Co. v. Fata Aluminum, Inc., 61 U.S.P.Q.2d 1545 (Fed. Cir. 2002); Demaco Corp. V. F. von Langsidofff Licensing Ltd., 7 U.S.P.Q.2d 1222 (Fed. Cir. 1988).

Moreover, despite the fact that this evidence of commercial success was properly filed with Applicant’s prior response and is important in the consideration of obviousness, **the Final Rejection of the Examiner is entirely silent to any**

consideration of such evidence! This is just yet another aspect in which the Examiner has failed to properly examine this case and to maintain a rejection that has totally no basis in fact.

With this in mind, Applicant's representative contacted Supervisor Gary Kunz, the Supervisor indicated that he agreed with Applicant's points and that the rejections did not appear to have merit. Accordingly, pursuant to the Supervisor's request, a courtesy copy of this response is being forward to the Supervisor to ensure that this case will receive a proper examination in light of the arguments set forth above which show that the Examiner's current rejections are completely without merit and should be withdrawn. The assistance of the Supervisor in bringing this case towards an allowance is greatly appreciated.

In light of the foregoing, Applicant submits that the present application is in condition for immediate allowance, and such action is earnestly solicited.

END OF REMARKS